

**REMARKS/ARGUMENTS**

The present application has been reviewed in light of the non-Final Office Action mailed November 9, 2010. Claims 100 and 103-108 are currently pending, claims 1-99, 101-102 and 109-110 having been cancelled. Reconsideration of the present application is respectfully requested. Applicant reserves the right to file one or more Continuation and/or Divisional Applications as appropriate. No new matter has been added by the present amendment.

Claims 100, 102-104 and 106-110 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,609,285 to Grant et al. in view of U.S. Patent No. 5,669,918 to Balazs et al. and U.S. Patent No. 5,855,312 to Toledano. Applicant respectfully submits, however, that Grant in view of Balazs and Toledano fails to disclose each and every element recited in independent claim 100.

In view of the cancellation of claims 102 and 109 herein, Applicant respectfully submits that the rejection of claims 102 and 109, under 35 U.S.C. §103(a) as being unpatentable over Grant in view of Balazs and Toledano, has been rendered moot and should be withdrawn.

As the BPAI reiterated in In re Wada and Murphy, an obviousness rejection under § 103 requires a suggestion of *all limitations in a claim*. Appeal 2007-3733 (B.P.A.I. Jan. 2008) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974); emphasis added). If the references, alone or in combination, do not teach or suggest each and every element of the claim, then the references cannot support a rejection under § 103. See Id.

Independent claim 100 recites a surgical device including, *inter alia*:

a trocar shaft disposed through the bore of the housing so  
as to be moveable relative to the housing, the trocar shaft including

a trocar and defining a reduced diameter region proximal of the trocar; and

an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, the anvil including:

an anvil sleeve extending proximally from the anvil and defining a bore ...; and

an anvil rod slidably disposed in the bore of the anvil sleeve, the anvil rod defining a proximal bore therein and a longitudinally extending trocar receiving slot formed through a proximal end of the anvil rod and defining an enlarged distal opening sized to receive the trocar therein from a side thereof. (emphasis added)

According to the present disclosure and as seen in FIGS. 8 and 10(a), and annotated FIGS. 11(a) and 11(b), reproduced below:

Extending in an axial direction through a centrally disposed opening of the staple and blade portion 106 is a trocar shaft 108. The trocar shaft 108 may be flexible. In one embodiment, the trocar shaft 108 is a cable. Disposed at a distal end 108a of the trocar shaft 108 is a trocar 110. The trocar 110 has a sharp or pointed end that is configured to be pushed through a section of tissue. In addition, the trocar 110 is configured to engage an anvil assembly 112, preferably by being insertable within a slot of the anvil assembly 112 for detachably fixing the trocar 110, and thus the trocar shaft 108 attached thereto, to the anvil assembly 112 as set forth more fully below. The surgical attachment 100 is configured such that the trocar shaft 108, and the anvil assembly 112 attached thereto, may be selectively moved, e.g., extended and retracted, relative to the staple and blade portion 106, as set forth more fully below. Specifically, the trocar shaft 108, having the trocar 110 disposed at its end, is extendable and retractable by movement in first and second, e.g., distal and proximal, directions, respectively, to a desired distance relative to the staple and blade portion 106. (see Para. [0095]).

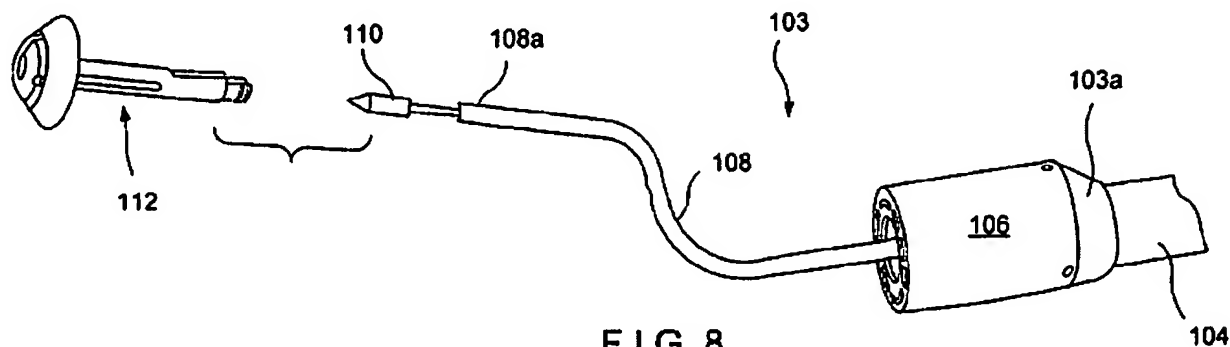


FIG. 8

The anvil assembly 112 also includes an anvil extension rod 206. The anvil extension rod 206 has a distal end 2061 that may be flat and that defines an opening 2062. The anvil extension rod 206 also has a central region 2063 that is round and that corresponds cross-sectionally to an inner diameter of the recess 2086 of the anvil sleeve 208. The distal end 2061 of the anvil extension rod 206 is cross-sectionally larger than the inner diameter of the recess 2086 of the anvil sleeve 208. The anvil extension rod 206 also has a proximal end 2063 that defines a trocar receiving slot 2065. (see Para. [0099]). (emphasis added).

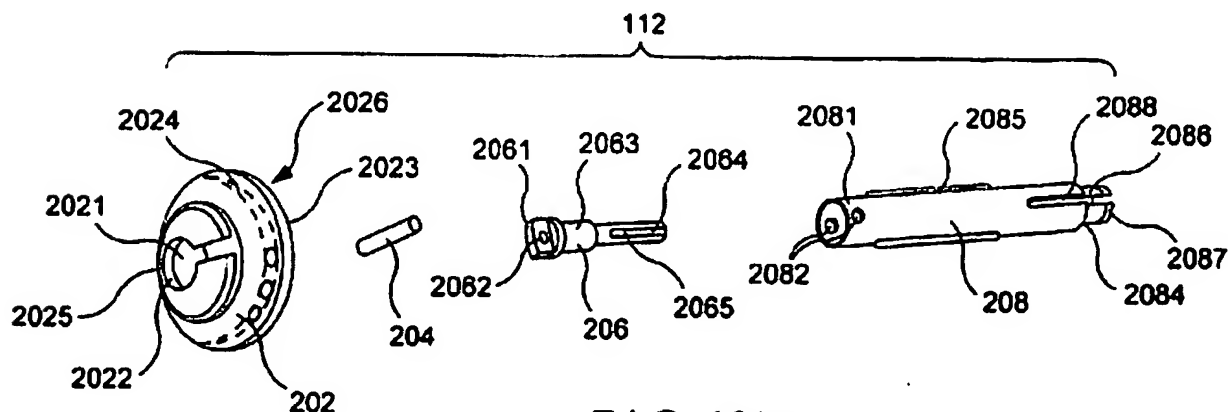
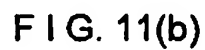
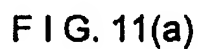


FIG. 10(a)

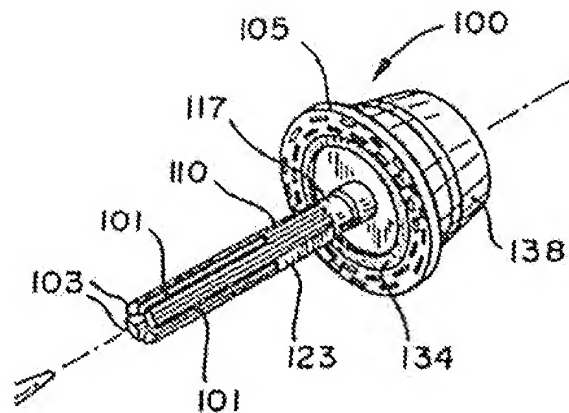


In use, the trocar 110 is pushed through a section of tissue desired to be stapled and is inserted within the trocar receiving slot 2065 of the anvil extension rod 206 so as to be axially fixed relative to the anvil extension rod 206. (see Para. [0123]).

Once the trocar 110 is inserted within the trocar receiving slot 2065 of the anvil extension rod 206, the trocar shaft 108 may then be retracted by operation of the first rotatable drive shaft 30 in the opposite direction. (see Para. [0140]).

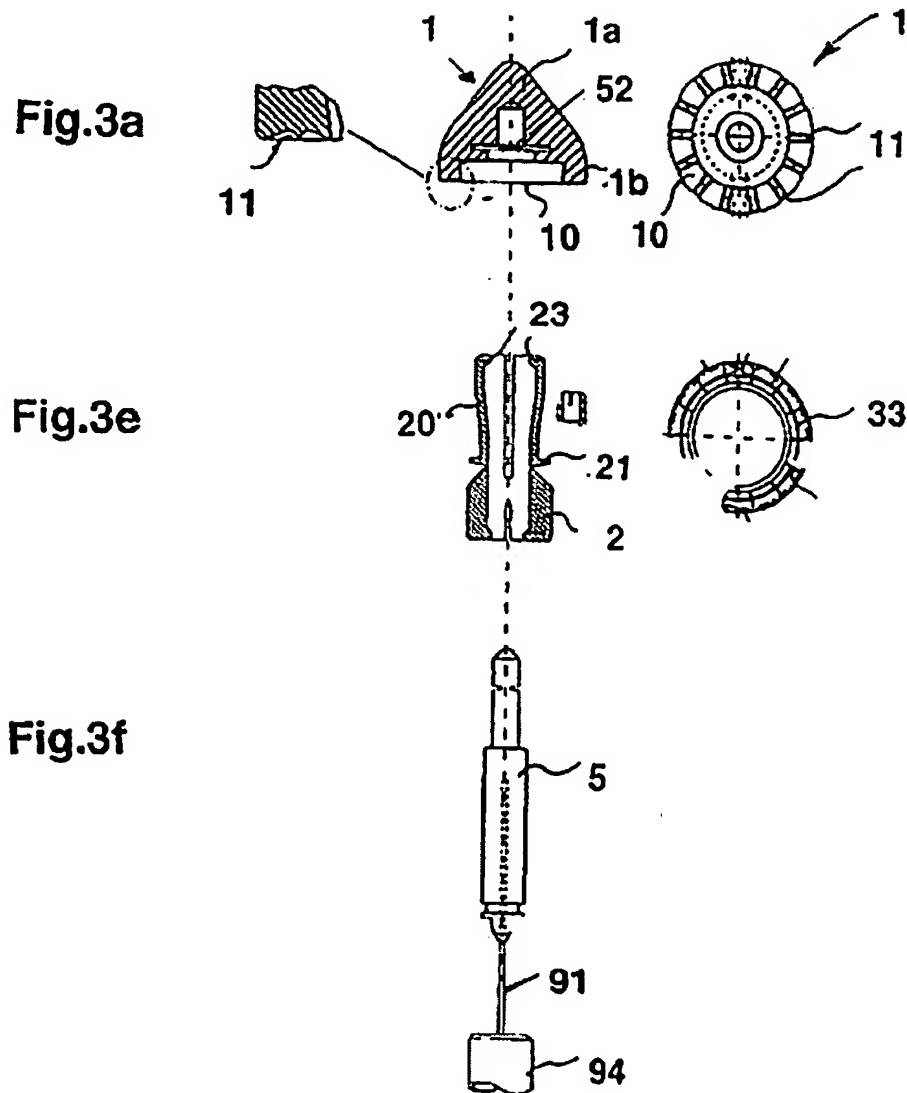
Applicant submits that the enlarged distal opening of the trocar receiving slot of the anvil rod of the present disclosure, enables the trocar to be connected to the anvil by connecting the trocar from the side of the anvil rod, as described and illustrated above.

In contrast, Applicant submits that Grant, as seen in the excerpt of FIG. 10 of Grant reproduced below, relates to a surgical anastomosis stapling instrument including an anvil assembly 100 having an anvil shaft 110 defining a plurality of longitudinal slits 101 extending from its proximal end which divide the anvil shaft 110 into a set of elongated, resilient fingers 103. According to Grant, preferably, the anvil shaft 110 is divided by the longitudinal slits 101 into four fingers 103 which can be flexed apart by the trocar tip 210 to allow the trocar 200 to be inserted in and removed from the anvil shaft 110. (see Col. 13, lines 48-55). Such insertion is accomplished from a rear-most face of anvil shaft 110.



Excerpt of FIG. 10 of Grant

Next, Applicant submits that Balazs, as seen in FIGS. 3a, 3e and 3f reproduced below, relates to a surgical instrument for preparing an anastomosis in minimally invasive surgery including an insertion head 1 defining radially oriented staple indentations 11, and a holder part 2 extending from insertion head 1 and defining a lumen therethrough for receiving a mandrel 5 therein from an end thereof.



As stated above, independent claim 100 recite a surgical device including, *inter alia*,

a trocar shaft disposed through the bore of the housing so as to be moveable relative to the housing, the trocar shaft including a trocar and defining a reduced diameter region proximal of the trocar; and

an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, the anvil including:

an anvil sleeve extending proximally from the anvil and defining a bore ...; and

an anvil rod slidably disposed in the bore of the anvil sleeve, the anvil rod defining a proximal bore therein and a longitudinally extending trocar receiving slot formed through a proximal end of the anvil rod and defining an enlarged distal opening sized to receive the trocar therein from a side thereof. (emphasis added)

Accordingly, in view of the foregoing amendments and remarks, Applicant respectfully submits that Grant in view of Balazs and Toledano fails to suggest or render obvious the features of independent claim 100. For at least these reasons, Applicant submits that the subject matter of independent claim 100, as a whole, is patentable under 35 U.S.C. §103(a) over Grant in view of Balazs and Toledano. Furthermore, since claims 103-104 and 106-108 depend from independent claim 100, and contain all of the limitations thereof, Applicant respectfully submits that the subject matter of claims 103-104 and 106-108, as a whole, is patentable for at least the reasons that independent claim 100 is patentable.

Claim 105 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Grant in view of Balazs and Toledano as applied to claim 108 above, and further in view of U.S. Patent No. 6,491,201 to Whitman. Applicant respectfully submits, however, that Grant in view of Balazs and Toledano and further in view of Whitman fails to disclose each and every element recited in claim 105 as presented herein.

The Examiner relies on Whitman for the disclosure of a surgical instrument having a flexible shaft movable relative to a housing by way of a rotatable driver selectively rotated by at least one motor via a controller. However, even assuming the teachings of Whitman proffered by the Examiner are correct, Applicant submits that Whitman would fail to cure any deficiencies of Grant, Balazs and/or Toledano because Whitman fails to teach or suggest an anvil rod slidably disposed in the bore of the anvil sleeve, the anvil rod defining a proximal bore therein and a



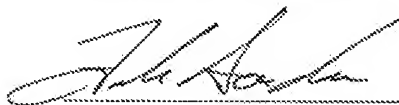
longitudinally extending trocar receiving slot formed through a proximal end of the anvil rod and defining an enlarged distal opening sized to receive the trocar therein from a side thereof, as substantially recited in independent claim 100.

In view of the foregoing, for at least the reasons that amended independent claim 100 is allowable over Grant in view of Toledano and further in view of Whitman under 35 U.S.C. §103(a), *inter alia*, Applicant respectfully submits that claim 105 is also allowable under 35 U.S.C. §103(a) over Grant in view of Toledano and further in view of Whitman.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, or resolve any outstanding matters, the Examiner is sincerely invited to contact the Applicant's undersigned representative at the number indicated below.

In view of the foregoing amendments and remarks, reconsideration of the application and allowance of claims 100 and 103-108 is earnestly solicited.

Respectfully submitted,



Francesco Sardone  
Reg. No. 47,918  
Attorney for Applicants

***Carter, DeLuca, Farrell & Schmidt, LLP***  
445 Broad Hollow Road – Suite 420  
Melville, New York 11747  
Telephone: (631) 501-5700  
Facsimile: (631) 501-3526

FS/jy